III.   REMARKS

A.   Status of the Claims:

Claims 1-12 and 15-23 are currently pending, of which claims 1 and 18 are independent claims. No claims are amended or added. Claims 13 and 14 are cancelled. No new matter has been added. Applicants request consideration and allowance of the pending claims in view of the following remarks.

B.   Claim Rejections under 35 U.S.C. § 102(e):

The Office Action rejects claims 1-8 and 15-23 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Published Application No. 2003/0204443 to Knox ("Knox"). Applicants respectfully traverse these rejections for at least the following reasons.

In order for a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated **only** if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")(emphasis added); see also Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

1.   Knox Does Not Teach a "Tamper-Resistant Secure Token" As Claimed In Claims 1-12 and 15-17 or a "Secure Tamper-Resistant Physical Token" As Claimed in Claims 18-23

Independent claim 1 recites, in part: "[a] method for managing network access of a computing device . . . where trusted enforcement of the access occurs at the device, comprising the steps of: . . . storing a network access parameter in memory of a tamper-resistant *secure* token . . ." (emphasis added). Independent claim 18 similarly recites, in part: "[a] system for managing network access of a computing device, which is capable of communicating via one or more networks, where trusted enforcement of the access occurs at the device, the system comprising: . . . *a secure* tamper-resistant physical token . . ." (emphasis added).

Applicants submit that Knox does not teach the "tamper-resistant *secure* token" or the "*secure* tamper-resistant physical token" (emphasis added) claim limitations. In section II, on pages 8 and 9 of the response to Office Action dated February 7, 2008 ("February 2008

Response"), Applicants asserted that Knox did not teach the above-quoted claim limitations. Specifically, Applicants asserted that the Office Action appeared to interpret the claimed "token" as Knox's switch, and that Knox's switch is neither secure nor tamper-resistant for two reasons. First, Applicants noted that Knox does not disclose the switch as secure or tamper-resistant. Second, Applicants cited paragraphs [0020] and [0021] of Knox and noted that Knox has no need for a tamper-resistant or secure token "as Knox's security is provided by its 'prepaid card' and 'DSL service manager'."

In the Response to Arguments section on page 7 of the current Office Action, the Office Action states that the Examiner disagrees that Knox does not disclose a tamper-resistant token because:

> Although the security is provided by the prepaid card and DSL service manager, the actual monitoring and usage controlling is executed on the switch . . . . Therefore, the security **to** the switch is required to prevent unauthorized parties to modify parameters set in the switch (Knox: [0027] lines 15-17: the security of the prepaid Internet switch to assure that prepaid customers do not exceed the amount of purchased prepaid Internet service). See Office Action, Page 7. (Emphasis added).

First, Applicants submit that the above-cited portion of the Office Action apparently *admits* that the prepaid Internet switch is not secure and tamper-resistant because the Office Action expressly references security as being provided "**to** the switch" (emphasis added) (as compared to "in the switch"). Therefore, the prepaid Internet switch is not a "*secure tamper-resistant* token" and the Office Action appears to impliedly admit such.

Second, even if the *above-cited* portion of lines 15-17 of paragraph [0027] appeared to indicate that the prepaid Internet switch has internal security and is tamper-resistant, which Applicants rebuts in the preceding paragraph, a reading of the *entirety of lines 15-17 of paragraph [0027]* makes clear that Knox, in lines 15-17, is referring to the *DSL service manager, not the prepaid Internet switch* as providing security. Specifically, lines 15-17 of paragraph [0027] recite:

> The *DSL service manager* has the security of the prepaid Internet switch to assure that prepaid customers do not exceed the amount of purchased prepaid Internet service and the security of point of sale activation to assure that the prepaid Internet service is not

stolen or otherwise improperly obtained. <u>See</u> Knox, Paragraph [0027]. (Emphasis added).

Thus, based on the express language quoted above, it is clear that Knox teaches that the *DSL service manager* provides security for the prepaid Internet switch and for the point of sale activation. <u>See</u> <u>Id.</u> Clearly, Knox is explaining that the DSL service manager provides security for two purposes: preventing customers from exceeding purchased Internet service, and ensuring that the prepaid Internet service is not stolen or otherwise improperly obtained. <u>See</u> <u>Id.</u>

Applicants submit that if the switch were itself tamper-resistant and secure, Knox would not expressly state that the *DSL service manager* "has the security" of the prepaid Internet switch. Applicants further submit that Knox teaches that the DSL service manager has *"the* security of the prepaid Internet switch," *not "a" or "additional"* security of the switch. Knox discloses no such redundancy in security; further, there would be no need for redundancy in security. Accordingly, based on the express language of Knox, security for the prepaid Internet switch is provided only from the DSL service manager, not from the DSL service manager *and* the prepaid Internet switch. The Knox switch is therefore a vulnerable and unsecure switch that requires security from the DSL service manager, rather than a "tamper-resistant *secure* token" or a *"secure* tamper-resistant physical token," (emphasis added) as claimed in claims 1 and 18.

Third, Applicants re-submit that "the cited reference must disclose *each and every* element of the claimed invention" (emphasis addedd). <u>See</u> Verdegaal Bros. Further, "[t]he fact that a certain . . . characteristic *may* occur or be present in the prior art is not sufficient to establish . . . that result or characteristic" (emphasis added). <u>See</u> MPEP §2112(IV); <u>see</u> <u>also</u> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Additionally, '[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art" (emphasis added). <u>See</u> MPEP § 2112(IV); <u>see</u> <u>also</u> Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Thus, even if Knox disclosed a "tamper-resistant *secure* token" or a *"secure* tamper-resistant physical token," which Applicants rebuts based on the above paragraphs, Knox does not disclose a *"tamper-resistant* secure token" or a "secure *tamper-resistant* physical token" as claimed in claims 1 and 18.

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Applicants submit that Knox fails to disclose that any of the components of its system, including, the prepaid Internet switch, the DSL service manager, and the prepaid card, are *"tamper-resistant"* (emphasis added). See Knox, Paragraph [0027]. Applicant further submits that at least the prepaid Internet switch is *not tamper-resistant* because it relies on external security to secure the prepaid Internet switch. See Id.

Further, as noted above, the fact that the prepaid Internet switch *may* be tamper-resistant is not sufficient to establish that characteristic as it must *necessarily* flow from the teachings of Knox. In this case, as noted above, Knox appears to teach that the prepaid Internet switch is *not tamper-resistant*. See Id. Accordingly, Knox fails to disclose that either the prepaid Internet switch, the DSL service manager or the prepaid card is *necessarily tamper-resistant*. See Id.

For at least these reasons alone, Knox does not teach or suggest all of the limitations of claims 1 or 18, or the claims that depend therefrom. Therefore, Applicants re-submit the arguments submitted in the February 2008 Response, in addition to the arguments provided herein, and request that the rejection of claims 1-12 and 15-23 be reconsidered and the claims be allowed on this basis alone.

**2.   Knox Does Not Teach a Token "Local To and Removably
Attachable to Said Device" As Claimed In Claims 1-12 and 15-
17 or a Token "Local To and Removably Attachable to The Device"
As Claimed in Claims 18-23**

Applicants submit that Knox also does not teach the token *"local to* and removably attachable to said device" or the token *"local to* and removably attachable to the device" (emphasis added) limitations of claims 1 and 18, respectively.

On page two, the instant Office Action cites to paragraph [0018] of Knox in support of its assertion that Knox teaches the token "local to and removably attachable to said device" limitation of claim 1, and makes a similar argument by analogy to claim 18. Specifically, the Office Action asserts that paragraph [0018] of Knox teaches that "the token can be disconnected from the device." Preliminarily, as noted above, it appears that the Office Action interprets the prepaid Internet switch as the claimed "token."

Applicants submit that in order to anticipate claims 1 and 18, Knox must teach *each and every* limitation of claim 1, and Knox does not do so. Specifically, Knox teaches that a RJ45 connector, of unknown length, connects the prepaid Internet switch 104 and the personal

computer 108. See Knox, Paragraph [0017]. The prepaid Internet switch 104 is therefore located at a distance that is *remote from* the personal computer 108 as dictated by the length of the RJ45 connector. See Id. As is known to those of ordinary skill in the art, the length of an RJ45 connector between a switch and a node or hub, for example, can range from 10 feet to approximately 328 feet. Accordingly, Knox does not teach that the switch is *"local to* and removably attachable to said device" or *"local to* and removably attachable to the device" (emphasis added) as claimed in claims 1 and 18, respectively.

Therefore, Knox does not teach the limitations of claims 1 and 18, or the claims that depend therefrom. For at least this reason alone, Applicants request that the rejection of claims 1-12 and 15-23 be withdrawn, and that claims 1-12 and 15-23 be allowed.

C.   Claim Rejections under 35 U.S.C. § 103(a):

The Office Action rejects claims 9-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable as obvious over Knox. Applicants respectfully traverse these rejections because a prima facie case of obviousness has not been made.

In order to establish a prima facie case of obviousness, a number of criteria must be met. The combined or modified references must teach or suggest all claim limitations. See MPEP § 2142 et seq. Additionally, there must be a reasonable expectation of success. See Id. Further, there must be some motivation or suggestion to make the proposed combination or modification of the references. See Id. Even in light of KSR v. Teleflex, 127 S. Ct. 1727 (2007), there must be a showing of a "teaching, suggestion or motivation" to make the proposed combination or modification of references. However, a prima facie case of obviousness is not made when the proposed combination or modification would require substantial re-design of the invention in the cited reference. See MPEP § 2143.01(VI).

When the application is under final rejection, Official Notice may be taken in support of a prima facie case of obviousness only in *rare* cases, i.e., when the facts noticed are capable of *instant and unquestionable* demonstration as being well-known at the time of the invention. See MPEP § 2144.03. It is *not* appropriate for the examiner to take official notice of facts without citing a prior art reference when the facts asserted are not capable of such demonstration. See Id.; In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). If the Examiner is relying on personal knowledge to support the assertion of what was well-known in the art at the

time of the invention, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See MPEP § 2144.03.

On pages five and six, with regard to claim 9, the Office Action admits that "Knox does not explicitly disclose wherein at least one of said additional network access parameters is associated with a second network." See Office Action, Pages 5 and 6. However, the Office Action alleges that "it would have been obvious to one of ordinary skill in the art to apply the method disclosed by Knox to a plurality of networks so that users have flexibility of choosing available networks associated with the switch." See Office Action, Page 6.

On page six, with regard to claim 10 (and by dependency, claims 11 and 12), the Office Action admits that "Knox does not explicitly disclose wherein said first network is an 802.11 network." See Office Action, Page 6. However, the Office Action alleges that "it would have been obvious to one having ordinary skill in the art to connect the switch wireless to a wireless router operating in 802.11 protocol." See Office Action, Page 6.

Applicants submit that even if it would have been obvious to one skilled in the art to modify Knox in the aforementioned ways, which Applicant makes no such admission, doing so would not teach or suggest all of the claimed limitations because the aforementioned claim 1 deficiencies noted in the above sections have not been cured, and claims 9-12 depend from claim 1. Accordingly, based on the dependency of claims 9-12 from claim 1, as well as for their additional limitations, claims 9-12 are patentable over Knox.

Applicant also submits that claims 9-12 are patentable over Knox because a prima facie case of obviousness has not been made since: (1) the Office Action improperly takes official notice of the limitations recited in claims 9 and 10 (and therefore in claims 11 and 12, which depend from claim 10); (2) the Office Action does not make a prima facie case that each of the limitations of claim 9 is taught or suggested; and (3) the proposed modification of the Knox invention would require substantial re-design of the Knox invention.

Claim 9 depends from claims 1 and 3, and therefore include the following limitations: "[a] method for managing network access of a computing device . . . [the method] comprising . . . storing a network access parameter in memory of a tamper-resistant secure token . . . said network access parameters being associated with a *first* network" and "further comprising the

step of storing one or more additional network access parameters in said secure token" and "wherein at least one of said additional network access parameters is associated with a *second* network" (emphasis added).

Claim 10 depends from claim 1, and therefore includes the following limitations: "[a] method for managing network access of a computing device . . . [the method] comprising . . . storing a network access parameter in memory of a tamper-resistant secure token . . . said network access parameters being associated with a first network . . . wherein said first network is an *802.11* network" (emphasis added).

1. The Office Action Improper Takes Official Notice

It is unclear whether the above-quoted language provided on pages five and six of the Office Action that refers to claims 9 and 10 (and claims 11 and 12, by dependency from claim 10) is an indication of the Office Action taking official notice of the limitations recited in those claims. However, if such is the case, a prima facie case of obviousness has not been made because taking official notice is improper in this case.

Applying MPEP § 2144.03 and In re Eynde, Applicants respectfully submit that because the application is under final rejection, the cases in which official notice may be properly taken is rare. Official notice may not be properly taken in this case because the noticed facts are not capable of instant and unquestionable demonstration as being well-known at the time of the invention.

The Office Action appears to take official notice of applying the method of claim 9 in Knox: "to a plurality of networks so that users have flexibility of choosing available networks associated with the switch." This method is not capable of instant and unquestionable demonstration as being well-known at the time of the invention because such method would require a complex series of steps wherein numerous components of the system interact with other components in order to flexibly allow the user to be connected to different networks through a single switch. Applicants also submit that the absence of specific cited prior art in the Office Action is further evidence that such method is not capable of instant and unquestionable demonstration.

The Office Action appears to take official notice of applying the method of claim 10 (and claims 11 and 12, by dependency) in Knox: "to connect the switch wireless to a wireless router operating in 802.11 protocol." This method is not capable of instant and unquestionable demonstration as being well-known at the time of the invention because such method would require the switch and the router, which are currently designed for wired communication to be equipped with wireless transmission equipment and to be configured to operate according to the 802.11 protocol. Applicants also submit that the absence of specific cited prior art in the Office Action is further evidence that such method is not capable of instant and unquestionable demonstration.

Pursuant to MPEP § 2144.03, because the Office Action appears to rely solely on personal knowledge of the Examiner to support the finding of what is known in the art, to maintain the rejection in the next action, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. Applicants respectfully request such affidavit or declaration.

For at least these reasons alone, the Office Action does not make a prima facie case of obviousness with regard to claims 9-12. Therefore, Applicants respectfully submit that claims 9-12 are patentable over Knox and request that claims 9-12 be allowed for at least this reason also.

2. The Office Action Does Not Make a Prima Facie Case That Each Of The Limitations Of Claim 9 Is Taught Or Suggested

A prima facie case of obviousness has not been made since the Office Action does not make a prima facie case that each of the limitations of claim 9 is taught or suggested. As noted above, the Office Action alleges that "it would have been obvious to one of ordinary skill in the art to apply the method disclosed by Knox to a plurality of networks so that users have flexibility of choosing available networks associated with the switch." See Office Action, Page 6. Applicants respectfully submit that even if such modification of the Knox invention would have been obvious, which Applicants make no such admission, the above-described modification does not teach or suggest each of the claim limitations of claim 9.

Specifically, the general method of allowing users to access a plurality of available networks associated with a switch does not teach or suggest the claim 9 limitation: "storing a

first network access parameter . . . associated with a <u>first</u> network . . . and one or more additional network access parameters . . . associated with a <u>second</u> network" (emphasis added).

For at least this reason alone, the Office Action does not make a prima facie case of obviousness with regard to claim 9. Therefore, Applicants respectfully submit that claim 9 is patentable over Knox and request that claim 9 be allowed for at least this reason also.

3. The Office Action Suggests a Modification That Would Require Substantial Re-Design of the Elements of Knox

A prima facie case of obviousness has not been made because the proposed modification of the Knox invention to the limitations of claim 9 would require substantial re-design of the invention.

Knox may disclose a prepaid internet access system wherein a user has access to a single network if the amount of time or the amount of data transfer that the user has purchased has not been exceeded. See Knox, Paragraphs [0017] and [0022]; Fig. 2. Knox may disclose that a prepaid internet switch 104 having a single, simple open/close switch 111 can monitor the time or data transfer, and cause the switch 111 to open and close thereby disconnecting and connecting a user's local personal computer 108 from a modem 110 communicatively coupled to the network 129. See Id.; Figs. 1 and 2.

In order to modify Knox to the invention that the Office Action describes on page 5 ("a plurality of networks so that users have flexibility of choosing available networks associated with the switch"), the Knox system would have to undergo extensive re-design. The prepaid internet switch 104 may have to be re-designed with capability to determine whether the time or data amount is associated with a first network or a second network. Further, the prepaid internet switch 104 may have to be re-designed to send control signals including the identity of the network. Additionally, the prepaid internet switch 104 may have to be re-designed to send control signals for connecting to the particular identified network. Further, the system may have to be re-designed to include and access configuration information for a plurality of networks to which the user may connect. Additionally, because the switch 111 currently functions as a simple open/close switch but would potentially have to allow communication with a first network while stopping communication with a second network, to maintain the current

open/close functionality, the switch 111 may have to be re-designed to provide for multiple contacts with the modem or may have to be replaced with a more complex device altogether. Finally, the invention may have to be re-designed to cause the system to configure or re-configure to connect to a selected network based on the network access parameter identified.

Accordingly, the proposed modification of the Knox invention to the limitations of claim 9 would require substantial re-design of the invention. For at least this reason alone, the Office Action does not make a prima facie case of obviousness with regard to claim 9. Therefore, Applicants respectfully submit that claim 9 is patentable over Knox and request that claim 9 be allowed for at least this reason also.

IV. CONCLUSION

The Commissioner is authorized to deduct any fees necessary to maintain this application pending, including, but not limited to, Request for Continued Examination and extension fees, from the undersigned's Deposit Account No. 50-0206.
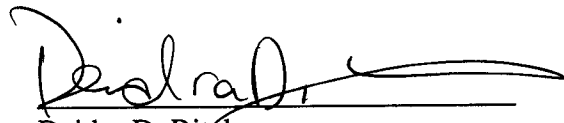
Respectfully submitted,

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Dated: October 30, 2008

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